

REMARKS

This amendment is responsive to the Office Action dated August 21, 2009. After its entry, claims 1-4, 7-15, 17, 18, and 22-26 are currently pending in this application and subject to examination. Claims 19 and 20 are cancelled and presented again as new claims 25 and 26, respectively. No new matter is added

Reconsideration of the application as amended is respectfully requested in view of the following remarks.

Objection to Claims 19 and 20

Claims 19 and 20 stand objected to as being in improper dependent form. Claims 19 and 20 are cancelled, which renders this objection moot. Claims 19 and 20 are presented again as new claims 25 and 26, which properly depend from claims 23 and 24, respectively.

Obviousness-Type Double Patenting Rejection

Claims 10, 11, and 18 stand rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1, 5, 7-9, 22, and 24-28 of U.S. Patent No. 6,921,563 to Goerlitz et al. (Goerlitz). In response, Applicants file concurrently herewith a Terminal Disclaimer disclaiming the terminal part of the statutory term of any patent granted on the present application which would extend beyond the expiration date of the full statutory term of Goerlitz. Applicants believe this Terminal Disclaimer obviates this rejection and respectfully request its withdrawal.

Rejection Under 35 U.S.C. § 103(a)

Claims 10, 11, and 18 stand rejected as obvious over Goerlitz. Claims 1-4, 7-15, and 17-20 stand rejected as obvious over U.S. Patent No. 5,876,814 to Oda et al. (Oda) in combination with U.S. Patent No. 6,682,797 to Otoi et al. (Otoi) in view of U.S. Patent No. 5,783,273 to Yamamoto et al. (Yamamoto) or U.S. Patent No. 5,321,030 to Hirose et al. (Hirose). This rejection is moot as to claims 19 and 20, which are cancelled. Applicants respectfully traverse as to claims 1-4, 6-15, 17, and 18, and new claims 25 and 26.

Claims 10, 11, and 18

Claims 10, 11, and 18 cannot be deemed obvious over Goerlitz, since Goerlitz cannot be used as a prior art reference for the purpose of establishing obviousness. This is because, pursuant to 35 U.S.C. § 103(c), Goerlitz does not qualify as 35 U.S.C. § 102(e) prior art for purposes of 35 U.S.C. § 103(a). Section 103(c) states, in relevant part, that “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g), of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” The present application is subject to the above provision because it was filed after the effective date of November 29, 1999. As recognized by the Examiner, Goerlitz is ostensibly a 35 U.S.C. § 102(e) reference for the purpose of this obviousness rejection under 35 U.S.C. § 103(a). However, the subject matter of Goerlitz was developed by a different inventive entity (*i.e.*, the inventorship of Goerlitz and that of the present application is not identical). Applicants submit that Goerlitz and the present application were, at the time the invention was made, subject to an obligation of assignment to the same entity, namely Ticona GmbH. As such, Goerlitz does not qualify as 35 U.S.C. § 102(e) prior art for purposes of establishing obviousness under 35 U.S.C. § 103(a). MPEP 706.02(l)(1), (2), (3), and 2146. Since the Examiner has not established claims 10, 11, and 18 as *prima facie* obvious, Applicants respectfully request withdrawal of this rejection.

Claims 1-4, 7-15, 17, 18, 25, and 26

Claim 1 recites, *inter alia*, “[A] process for producing a packaging composed of a thermoformable film composed of thermoplastic polyolefins … which comprises using, in the thermoformable film, an amount in the range of from 20 to 80 % by weight, based on the total weight of polyolefins, of COC …” This clearly implies that the recited thermoformable film is composed of a *blend* of thermoplastic polyolefins, from 20 to 80 % by weight of which is the recited COC, based on the total weight of polyolefins.

Oda discloses a method for preventing a plastic material from becoming colored by the contents of a container in a filling and heat sterilization process. Column 1, lines 6-10, of Oda. This method comprises, *inter alia*, filling and sealing colored contents in a packaging container having an inner layer comprising a plastic material. Column 1, lines 53-64, of Oda. This inner layer can be a COC alone or in combination with an olefin-based resin. Column 4, line 1, to column 7, line 13, and column 7, line 58, to column 8, line 8, of Oda. However, Oda teaches that this combination of COC with an olefin-based resin takes the form of ***a COC layer laminated to an olefin-based resin layer***. Column 7, lines 49-54, and Example 2 of Oda. Oda neither teaches nor suggests employing a blend of COC and an olefin-based resin in a single layer.

In order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Oda fails to teach or suggest a thermoformable film composed of a blend of from 20 to 80 % by weight of COC with one or more thermoplastic polyolefins. Moreover, none of the other references cited by the Examiner provide the skilled artisan with any suggestion or motivation to modify the method of Oda to employ such a blend as the inner layer in its containers instead a COC layer laminated to an olefin-based resin layer. Therefore, the combined disclosures of Oda, Otoi, Yamamoto, and Hirose fail render claim 1, or dependent claims 2-4, 7-15, 17, 18, 25, and 26, *prima facie* obvious. Applicants respectfully request withdrawal of this rejection.

Claims 22-24

Applicants note that the Examiner did not specifically address claims 22-24 in the August 21, 2009 Office Action. Since the Examiner did not indicate these claims to be allowable, Applicants assume that any specific rejection of these claims was inadvertently omitted from the action. In any case, Applicants respectfully submit that these claims are patentable over the cited references for the same reasons provided *supra* regarding claims 1-4, 7-15, 17, 18, 25, and 26.

In view of the foregoing amendment and remarks, Applicants submit that the pending application is in condition for allowance.

Payment in the amount of \$490.00 to cover the fee required by 37 C.F.R. § 1.17(a)(2) for a two-month extension of time is submitted concurrently herewith. Should any other fees be required in connection with this Amendment, the Director is hereby authorized to charge any fees due or outstanding, including any extension fees, or credit any overpayment, to Deposit Account No. 03-2775, under Order No. 13975-00002-US, from which the undersigned is authorized to draw.

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Respectfully submitted,

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